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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,269	02/17/2004	Keith M. Grispo	L-F / 223	2232
26875	7590	12/05/2006	EXAMINER	
WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			GILBERT, ANDREW M	
			ART UNIT	PAPER NUMBER
			3767	

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/780,269

Applicant(s)

GRISPO, KEITH M.

Examiner

Andrew M. Gilbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 18-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Acknowledgments***

1. This office action is in response to the reply filed on 9/22/2006.
2. In the reply, the Applicant responded to the election/restriction requirement.

### ***Election/Restrictions***

3. Applicant's election without traverse of Group III: claims 11-17 in the reply filed on 9/22/2006 is acknowledged.
4. Claims 1-10, 18-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/22/2006.

### ***Claim Notes***

5. The Examiner notes that the claims language "first purges" and "second purges" is a recitation of a product by process. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product (*In re Fessman*, 489 F2d 742, 180 USPQ 324 (CCPA 1974)). Whether a product is patentable depends on whether the process by which it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable (*In re Klug*, 333 F2d 905, 142 USPQ 161 (CCPA 1964)). To read on the claimed limitations a prior art reference merely needs to meet the structural requirements of the product. That is, if a prior art reference is capable of first purging air from the first syringe and then is capable of next purging air from the second syringe then the prior art reference will read on the claimed limitations.

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6. Furthermore, the Examiner notes that the term "automatically" (see claim 1, ln 4) has been interpreted as defined in Webster's Dictionary: "done or produced as if by machine". That is, a prior art reference would read on the claimed limitations if the injector device purges air or is capable of purging air through an action of the device. The current claim limitations of the Applicant do not necessitate that the purging of air be conducted by a programmed purge routine controlled by the injector processor and drive members.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by McWhorter et al (4044757). McWhorter et al discloses a dual head injector comprising: a first head (58) configured to receive a first syringe (24); a second head (63) configured to receive a second syringe (22); and, Y-tubing coupling (28) the first and second syringe; the dual head injector configured to automatically purge substantially all of the air from the first and second syringes and the Y tubing (Summary; col 4, lns 29-47; col 5, lns 21-26); the Y-tubing including a first section coupled to the first head, wherein the

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first head first purges air from the first syringe and the first section of tubing; the Y-tubing including a second section coupled to the second head, a connector coupled to the first and second sections, and third section coupled to the connector, wherein the second head next purges air from the second syringe, the second section of tubing, the connector and the third section of tubing (Fig 1-9; Summary; col 4, Ins 29-47; col 5, Ins 21-26); wherein the first syringe is a pre-filled syringe of contrast media (col 3, Ins 11-18) and wherein the second syringe includes a saline solution (col 3, Ins 4-10).

9. Claims 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Cornacchia et al (5472403). Cornacchia et al discloses a dual head injector comprising: a first head (36) configured to receive a first syringe (2); a second head (38) configured to receive a second syringe (4); and, Y-tubing coupling (22) the first and second syringe; the dual head injector configured to automatically purge substantially all of the air from the first and second syringes and the Y tubing (Summary; col 3, Ins 60-65); the Y-tubing including a first section coupled to the first head, wherein the first head first purges air from the first syringe and the first section of tubing; the Y-tubing including a second section coupled to the second head, a connector coupled to the first and second sections, and third section coupled to the connector, wherein the second head next purges air from the second syringe, the second section of tubing, the connector and the third section of tubing (Fig 1, Summary, col 2, Ins 50-col 3, Ins 65); wherein the first syringe is a pre-filled syringe of contrast media (col 2, Ins 53-55; wherein the Examiner

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notes that radionuclide is a type of contrast agent – see Summary) and wherein the second syringe includes a saline solution (col 2, lns 63-65).

10. Claims 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Fukuda. Fukuda discloses a dual head injector comprising: a first head (3a) configured to receive a first syringe (1a); a second head (3b) configured to receive a second syringe (1b); and, Y-tubing coupling (2; col 1, lns 20-25) the first and second syringe; the dual head injector configured to automatically purge substantially all of the air from the first and second syringes and the Y tubing (Summary); the Y-tubing including a first section coupled to the first head, wherein the first head first purges air from the first syringe and the first section of tubing; the Y-tubing including a second section coupled to the second head, a connector coupled to the first and second sections, and third section coupled to the connector, wherein the second head next purges air from the second syringe, the second section of tubing, the connector and the third section of tubing (Fig 1-9, Summary; wherein the Examiner notes the device is fully capable of performing the Applicant's claimed limitations – see discussion above in Claim Notes); wherein the first syringe is a pre-filled syringe of contrast media (Fig 9; 1a) and wherein the second syringe includes a saline solution (Fig 9, 1b).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Meaney et al (6879853); Emig et al (6471674); Wallis (5236417).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571) 272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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SUPERVISORY PATENT EXAMINER

